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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,631	05/25/2000	William H. Barber	387953	5757

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EXAMINER

BARTUSKA, FRANCIS JOHN

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/578,631

Applicant(s)

BARBER, WILLIAM H.

Examiner

F. J. BARTUSKA

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18-56 and 59-83 is/are rejected.
- 7) ☒ Claim(s) 16, 17, 57 and 58 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The Declaration filed on 19 June 2003 under 37 CFR 1.131 is sufficient to overcome the Hamm et al reference.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8, 18, 20-24, 26-29, 36-38, 42-53, 59-65, 67-70, 77-79 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al. Kanoh et al show kiosks 3, which dispense CDs, see col. 1, lines 7-12, and receive them back. The kiosks of Kanoh et al are connected to a remote host computer 50, see col. 5, lines 33-40. Kanoh et al include a reader 61 that reads bar codes on the CDs and indicates when a CD is erroneously returned, see col. 6, lines 13-16. Kanoh et al maintain an inventory of the rented CDs and the location of the CDs in the kiosk, see col. 7, lines 35-64. Kanoh et al disclose electronic transmission of charges to a credit card company, see col. 4, lines 28-31 and 47-49 and col. 9, lines 43-50 and col. 10, lines 5-12. However, Kanoh et al do not disclose electronically transmitting a receipt to the user. Kitchen et al disclose electronically presenting bills including credit card bills to the payor, see col. 6, line 6. Since credit card bills show charges for purchases and services and payments received it comprises a receipt. It would have been obvious to one of

ordinary skill in the art in view of the showing and teaching of Kitchen et al to provide the device of Kanoh et al with means to electronically transmit the credit card bill to the customer to provide the customer with a record of the transaction.

Claims 30-32, 71 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al as applied to claim 2 above, and further in view of Brindze et al. Kanoh et al, as modified by Kitchen et al, disclose all the features of the applicant's claimed invention except concentric markings on the CDs. Brindze et al show CDs with unique concentric markings to keep track of each CD. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Brindze et al to provide the CDs of Kanoh et al with unique concentric markings to keep track of each CD.

Claims 9-12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al as applied to claim 1 above further in view of Reid et al. Kanoh et al, as modified by O'Neil et al, show all the features of the applicant's claimed invention except a storage carousel for the CDs. Reid et al show a storage

carousel 32 for holding the articles. It would have been obvious to one of ordinary skill in the art to substitute the carousel of Reid et al for the storage means of Kanoh et al since they are equivalent and either would work equally well in the dispenser of Kanoh et al.

Claims 13, 54, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al as applied to claim 1 above further in view of Takahashi et al. Kanoh et al, as modified by Kitchen et al, disclose all the features of the applicant's claimed invention except the device to polish the CDs. It would have been obvious to one of ordinary skill in the art in view of the CD polishing device shown in Takahashi et al to provide the device of Kanoh et al with a device to polish the CDs to remove scratches or stains from the CDs.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al as applied to claim 2 above, and further in view of Takahashi et al. Kanoh et al, as modified by Kitchen et al, disclose all the features of the applicant's claimed invention except the device to polish the CDs. It would have

been obvious to one of ordinary skill in the art in view of the CD polishing device shown in Takahashi et al to provide the device of Kanoh et al with a device to polish the CDs to remove scratches or stains from the CDs.

Claims 25, 34, 35, 66, 75 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al as applied to claim 1 above further et al in view of Dedrick. Kanoh et al, as modified by Kitchen et al, show all the features of the applicant's claimed invention except sending advertisements according to a user profile. Dedrick discloses sending advertisements according to a user profile. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Dedrick to tailor the advertisement in Kanoh et al according to user profiles.

Claims 33, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al as applied to claim 1 above further in view of Iida. Kanoh et al, as modified by Kitchen et al, show all the features of the applicant's claimed invention except an optical writing system. Iida disclose an optical writer 28 that

writes data to the CDs. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Iida to provide the device of Kanoh et al with an optical writer to write data to the CDs.

Claims 39-41 and 80-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Kitchen et al as applied to claim 1 above further in view of Iida. Kanoh et al, as modified by Kitchen et al, show all the features of the applicant's claimed invention except a casing with an address and packaging for mailing. Iida discloses a casing and address label and packaging for mailing the CDs in col. 15, lines 16-22. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Iida to provide the device of Kanoh et al with a casing and means to address and mail the CDs.

### ***Allowable Subject Matter***

Claims 16, 17, 57 and 58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in



independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

4. The applicants' remarks have been considered but have not been found persuasive in view of the art as now applied.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J. BARTUSKA whose telephone number is 703-308-1111. The examiner can normally be reached on MONDAY-FRIDAY (ALTERNATE FRIDAYS OFF).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT P. OLSZEWSKI can be reached on 703-308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-305-7687 for After Final communications.

Application/Control Number: 09/578,631  
Art Unit: 3627

Page 9

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

fjb  
August 5, 2003

  
F. J. BARTUSKA  
PRIMARY EXAMINER 8/5/03